

REMARKS

Further consideration of this application is requested, in light of the accompanying Request for Continued Examination and the present submission. In light of the amendments and remarks herein, as well as in prior filings in this case, allowance of the pending claims is respectfully requested.

In the Advisory Action mailed in this case, Examiner Priddy addressed only two aspects of the response to final action in this case. First, he took issue with Applicant's demonstration that Dunn does not show the tensile strength language of the claims, and stated that "the cord of Dunn et al. is capable of maintaining a desired distance or orientation of two adjacent bone portions **in some scenarios**." (Page 2 of Advisory Action (emphasis added)). This statement defeats the inherency the Examiner must rely on for a rejection. The Examiner acknowledges that Dunn does not show the tensile strength feature in the cord as recited in the claim, but depends on inherent disclosure. It is axiomatic, however, that inherent disclosure can only occur where "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." MPEP 2112 (citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)) (internal quotations omitted). The comments in the Advisory Action only state that that Dunn might show a feature in some scenarios, that it, that it is possible but not necessary to glean the feature from the reference. Respectfully, that is not enough to establish the inherent presence of a feature.

The second issue addressed in the Advisory Action is also based on inherency, in which the Examiner believes that anything providing an additional layer inherently provides abrasion resistance “regardless of it being disclosed as providing this abrasion resistance.” Extended to a logical conclusion, that reasoning suggests that placing sandpaper on the outside of an element is an “abrasion resistant coating,” even though designed to create abrasion. While it may be reasonable to suggest that many things can be a “coating,” it cannot be said that all of those things are abrasion resistant.

Other arguments made in the response to the final action were not rebutted or otherwise addressed. For example, claims 2, 3 and 14 were discussed in the response to the final action as well as an earlier response, and the demonstration of their allowability in those filings has not been rebutted. As another example, the showing that the Hlavacek reference cannot be combined with the Dunn reference as the final action suggested, because the permanent nature taught in Dunn for its device is defeated by making part of it biodegradable. As yet another example, the final action and Advisory Action did not discuss the “means” elements in claims 36 and 37 sufficiently to support a rejection. For the Examiner’s convenience, the remarks previously made concerning the claims will be repeated below, and the substance of earlier filings is also incorporated herein by reference.

The final action realleged that the combination of the Poirier reference and the Dunn reference renders independent claim 1 obvious. However, the combination does not show all features of claim 1, and the Poirier reference teaches away from the combination proposed by the Examiner. As previously pointed out, claim 1 recites a sheath that provides an abrasion resistant coating to an inner cord, and the Office Action asserts that item 12 of Poirier is a “cord” and item

16 is a “sheath.” The Office Action asserts that item 16 provides the recited coating, but gives no evidence, reasoning, or other explanation of how it reached that conclusion. There is no explicit or inherent disclosure of item 16 providing abrasion resistance, and there is no reason apparent from the reference for it to do so, since another layer is over item 16. Moreover, Poirier explains that its structure operates like a “Chinese finger-trap,” relying on friction to lock together adjacent layers. One of ordinary skill would understand from that disclosure that item 16 is not an “abrasion resistant coating” because of Poirier’s need for frictional joining. Thus, not only is the burden of proving unpatentability not met, but the Poirier reference understood as a whole does not show a sheath that provides an abrasion resistant coating.

The Office Action recognizes that Poirier does not disclose a radiopaque element nor bone fasteners. One of ordinary skill would not believe it obvious to import those items from Dunn to Poirier because Poirier teaches against those modifications. Poirier teaches that all of its layers should break simultaneously so as to provide maximum strength (column 2, lines 34-36). Making one portion of the Poirier cord of a different material, e.g. a radiopaque material, rather than of one material (e.g. nylon as taught by Poirier), will defeat or at least make much more difficult that goal of simultaneous breakage taught by Poirier.

The use of screws as shown in Dunn also runs against Poirier’s teachings. If such screws are inserted through the Poirier cord, the ability of the cord to operate as a “Chinese finger-trap” as taught is impaired by the screw’s separation of and damage to the fibers in the respective parts. In the Dunn reference, of course, the screws are placed through eyelets formed in part of the Dunn ligament. Creating such eyelets in the Poirier cord, as taught in Dunn, requires the Poirier outer layers to be peeled back or drawn away from an inner braid, and that inner braid is

woven into itself. The several layers of Poirier cannot each be woven into each other. The Poirier cord, on the contrary, is intended to have each of its layers extend along the entirety of the ones under it, so that the strength and simultaneous breaking qualities taught by Poirier are not compromised. Introducing the screw-related disclosure from Dunn into Poirier would not be considered obvious by one of ordinary skill because it would defeat Poirier's goals and would change its operative principles.

For at least the reasons given above and in prior filings, a showing of unpatentability of claim 1 over Dunn by itself, or over the Poirier reference combined with Dunn, has not and cannot be made. Dependent claims 2-35 are allowable at least because of their dependence from claim 1. In a prior response in this case, it was pointed out that these dependent claims may be allowable on their own merit as well. As examples, it was shown that claims 2, 3 and 14 were not anticipated by the Dunn reference nor obvious over the Poirier and Dunn references. Those remarks were not rebutted by any evidence or reasoning in the present Office Action. The Dunn reference does not disclose the radiopaque element or filament as recited in claims 11-13 as well. Accordingly, it is respectfully requested that the dependent claims be reconsidered and passed to issue as well.

Claim 27 was rejected over a combination of the Dunn reference and the Hlavacek reference. As discussed in the previous response, Dunn teaches away from using bioabsorbable materials because its ligament is a permanent replacement for a natural ligament. See e.g. Abstract; column 1, lines 6-8; column 2, lines 20-30, 33-39, 50; column 3, lines 44-46. A bioabsorbable material is, by definition, not "permanent." Page 9 of the comments in the present Office Action offer some additional remarks concerning claim 27. It is agreed that the claim

recites a biodegradable material in a “comprising” claim, as the Examiner stated. However, that is irrelevant to the point that the Dunn reference teaches permanence, and the biodegradable material of Hlavacek impairs such permanence. If Dunn’s item 30 includes some measure of biodegradable material, it will lose some or all of its ability to provide shape to the load-bearing item 20 as the material degrades. If Dunn’s item 20 includes biodegradable material, its ability to bear a load and/or be held by screws will diminish as the material degrades. The permanent replacement characteristic of the Dunn ligament would be negatively affected by introduction of a biodegradable material. Accordingly, one of ordinary skill would not be motivated to modify the Dunn reference with the Hlavacek reference as suggested in the Office Action.

With respect to independent claims 36 and 37, each includes features of claim 1 that are not present in the relied-on references, as discussed above. Claim 36 also includes a “means-plus-function” element that was not addressed in the Office Action. To reject this claim, the Examiner must find an element in the relied-on art that (A) performs the function specified in the claim, (B) is not excluded by any explicit definition in the specification for an equivalent, and (C) is an equivalent of the means-plus-function limitation, and she must provide an explanation and rationale as to why the element is an equivalent. See MPEP 2183. The interpretation of the “means” element must focus on the structure in the specification for performing the stated function and equivalents. See MPEP 2182. The Office Action did not analyze the “means” feature of claim 36 at all, and it did not provide the required explanation and rationale as to why some portion of Dunn and/or Poirier is an equivalent of that feature. For this additional reason, a sufficient case of anticipation or obviousness of claim 36 has not been made.

Claim 37 also includes a “means” element that was not addressed in the Office Action. In addition, claim 37 recites a radiopaque filament engaged with either the cord or the first sheath. That language makes clear that the recited filament is not the cord or the first sheath, but is engaged with one of them. The Office Action asserted that Dunn discloses “radiopaque filaments spirally wound around at least one of the cord, the first sheath or the second sheath” (pages 2-3 of the Office Action), but did not specify where in Dunn that disclosure was found. The only references to radiopaque materials found in Dunn refers to the material of which item 30 is made. No separate radiopaque filament that is wound around items 20 or 30 of Dunn, or any other part of the reference, is disclosed in Dunn. As noted above Poirier teaches away from introducing non-uniform parts into its cord so as to maintain simultaneous breakage of all parts.

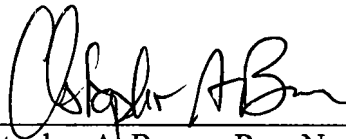
New claims 59-60 are also presented, and they are supported at least by Figure 1 and associated text. No new matter has been added. Neither of the Dunn or Poirier references show all elements of claim 59, including the movability between the cord and the sheath, the abrasion resistance, and a separate radiopaque fiber as recited in the claim. With respect to movability, it is noted that the Poirier reference relies on frictional engagement and a lack of movement between its layers for its operation, and the Dunn reference specifically teaches friction-fitting its item 40 to its item 20. Similarly, neither reference shows a radiopaque fiber between a cord and a sheath, as recited in claim 60.

To summarize, the Examiner is respectfully requested to reconsider and withdraw the present rejections of the pending claims on at least the bases given above. The above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the

Office Action in the most expedient fashion. Applicant reserves the right to later contest positions taken in the Office Action that are not specifically addressed herein. Further, no limitation of the claims is intended by any of the remarks herein. The claims are intended to have the full scope to which their language entitles them, including equivalents.

In conclusion, reconsideration and withdrawal of the rejections of the claims based on the remarks presented is respectfully requested. The undersigned attorney invites Examiner Priddy to call to discuss any further issues that may remain.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Christopher A. Brown', is written over a horizontal line.

Christopher A. Brown, Reg. No. 41,642
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
Chase Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

4002-3434:CAB:#480102